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Group Art Unit	2838
Examiner Name	P. Tibbits
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ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
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- ☐ Amendment / Response
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  - ☐ Affidavits/declaration(s)
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- ☐ Certified Copy of Priority Document(s)
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Firm or Individual name	Adan Ayala, Esq.
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UTILITY PATENT

B&D No. TN-1379A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

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1/11/02
Appeal Brief

In re application of: **Daniele C. BROTTO et al.**

Serial No.: **09/782,539**

Examiner: **P. Tibbits**

Filed: **February 13, 2001**

Group Art Unit: **2838**

For: **POWER TOOL WITH MEANS FOR OBTAINING PRODUCT USE INFORMATION (as amended)**

Assistant Commissioner for Patents
Washington, DC 20231

APPEAL BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington DC 20231 on 12-3-2001

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UTILITY PATENT

B&D No. TN-1379A

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Washington, DC 20231

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Adan Ayala

Dear Sir:

I. INTRODUCTION

In response to the Final Office Action mailed August 8, 2001, a Notice of Appeal was mailed on October 5, 2001, for the above-identified application. The present appeal brief is being timely filed in triplicate, as required under 37 CFR § 1.192.

II. REAL PARTY IN INTEREST

The real party in interest in the present case is Black & Decker Inc. An assignment transferring all rights to the present application and resulting patents was filed in the parent application. The assignment was recorded on April 15, 1999, and can be found at Reel 9911, Frame 0256.

III. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences related to the present case are currently pending.

IV. STATUS OF CLAIMS

Claims 25-32 are currently pending in the present application. Claims 25-32 are rejected and presently appealed.

V. STATUS OF AMENDMENTS

No amendment has been filed in response to the Final Office Action.

VI. SUMMARY OF INVENTION

Pursuant to 37 CFR § 1.192 and MPEP § 1206, Applicant/appellant hereby provides a concise explanation of the inventions defined in the claims involved in the present appeal. This explanation refer to the specification by page and line number and to the drawings, as required by the CFR and the MPEP rules. However, the following explanation only refers to the embodiments disclosed in the specification and does not discuss alternative mechanisms that would be covered by

the claims. Accordingly, the following explanation should not be used to limit the scope of the claims.

Independent Claim 25 calls for a power tool 40 comprising a memory 44 for storing use profile information about the tool 40. Spec., p. 8, lns. 3-10. Use profile information is information stored in the memory 44 concerning the manner in which the tool 40 is used. This information can include tool temperature, length of use, number of times the tools has been turned on, etc. Spec., p. 8, lns. 12-14.

Claim 26 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 26 further defines that the stored information comprises at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on. Spec., p. 8, lns. 12-14.

Claim 27 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 27 further defines that the stored information is downloadable. Spec., p. 8, lns. 15-16.

Claim 28 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 28 further defines that the stored information is downloadable into a computer. Spec., p. 8, lns. 15-16.

Claim 29 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 29 further defines that the stored information is downloadable into a reader apparatus. Spec., p. 8, lns. 15-16.

Claim 30 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 30 further defines that the stored information comprises length of use. Spec., p. 8, lns. 12-14.

Claim 31 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 31 further defines that the memory 44 is non-volatile. Spec., p. 8, lns. 10-11.

Claim 32 is dependent upon Claim 25, and thus includes all the elements of Claim 25 described above. Claim 32 further defines that the memory 44 comprises an E^2PROM memory. Spec., p. 8, lns. 10-11.

VII. ISSUE

Whether Claims 25-32 are unpatentable under 35 USC § 103(a) over US Patent No. 4,636,961 ("Bauer").

VIII. GROUPING OF CLAIMS

Claims 25 and 31-32 stand together as Group I; Claims 26 and 30 stand together as Group II; Claims 27-28 stand together as Group III; and Claim 29 stands alone as Group IV.

IX. ARGUMENT

Claims 25-32 are Patentable under 35 USC § 103(a) over Bauer.

The Board should reverse the Examiner's improper final rejection of Claims 25-32 under 35 USC § 103(a) based on US Patent No. 4,636,961 ("Bauer"). In particular, Bauer does not show all the claimed elements, and no suggestion exists for modifying Bauer with the missing elements. Therefore, the Examiner's rejection was improper and should be reversed.

As mentioned above, Claims 25-32 are grouped in four separate groups. First, Claims 25 and 31-32 stand together as Group I. Second, Claims 26 and 30 stand together as Group II, as they are separately patentable over the other claims. This is because both claims call for the stored information to include length of use.

Further, Claims 27-28 stand together as Group III, because they both call for the stored information to be downloadable, which is not explicitly claimed in the other claims. Finally, Claim 29 stands alone as Group IV. Claim 29 calls for the stored information to be downloaded into a reader apparatus.

A. Claims 25 and 31-32 are Patentable over Bauer.

The Board should reverse the Examiner's final rejection of Claims 25 and 31-32 for not including having all the claimed elements.

Claim 25 calls for a power tool comprising a memory for storing use profile information about the tool. Claims 31-32 are ultimately dependent upon Claim 25 and thus include the elements of Claim 25.

Admittedly, Bauer discloses a power tool with a memory 15. However, Bauer does not disclose a memory for storing use profile information about the tool. Instead, Bauer discloses a

power tool with a read-only memory (ROM), which is programmed with control information prior to sale. Bauer, col. 3, lns. 35-37. The Examiner admits that the ROM has values that "are fed to the control device of the motor of the tool... As a result the optimum rotary speed of the electric motor of the tool is adjusted." In other words, the ROM contains control information for controlling the rotary speed value (Bauer, col. 4, lns. 37-40), but not use profile information concerning the manner in which the user is using the power tool.[1]

By contradistinction, Claim 25 calls for "a memory for storing use profile information about the tool." This information would include, for example, the tool temperature, length of use, number of times the tool has been turned on, etc. (See, e.g., Specification, page 8, lines 13-14.) This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Therefore, Bauer does not disclose or suggest all the claimed elements.

In addition, there is no suggestion to modify Bauer's preprogrammed memory storing control information with a storage memory for storing profile use information as implied by the Examiner for several reasons. First, such modification would change the principle of operation. According to the CCPA, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the present case, the ROM in Bauer is used for controlling the motor speed. Since the Bauer memory does not store information as to how the user uses the tool, the principle of using a memory for controlling a parameter is changed.

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[1] The Examiner notes that Bauer also discloses a programmable ROM (PROM) which "can be programmed by the user and easily reprogrammed." Bauer, col. 4, lns. 42-44. However, the information that is stored in the PROM is still control information relating to the rotary speed, not information as to how the user is using the tool.

Second, such modification would render the Bauer device unsatisfactory for its intended purpose. According to the CAFC, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As admitted by the Examiner, the Bauer device has a memory with control information for controlling and optimizing the motor speed. If the Bauer memory is replaced with a memory for storing use profile information, then the memory will not have the necessary control information for controlling and optimizing the motor speed. Accordingly, such modification would render the Bauer device unsatisfactory for its intended purpose. For these reasons, no suggestion exists to modify Bauer as proposed by the Examiner. Therefore, Bauer cannot render Claims 25 and 31-32 unpatentable.

The Examiner argues that the above arguments are not persuasive as Claim 25 does not call for "a temporal sequence for storing use profile information." While it is true Claim 25 does not call for such temporal sequence, Claim 25 calls for "use profile information," which has been defined to be information concerning the manner in which the user uses the power tool. Therefore, the Examiner's argument must fail. Accordingly, the Board should reverse the Examiner's rejection of Claims 25 and 31-32.

B. Claims 26 and 30 are Patentable over Bauer.

The Board should reverse the Examiner's final rejection of Claims 26 and 30 for not including having all the claimed elements.

Claims 26 and 30 are ultimately dependent upon Claim 25, and thus the arguments of Section IX(A) above apply. In addition, Claim 30 requires that the stored information comprise

length of use, i.e., how long the power tool has been used. Further, Claim 26 calls for other values that may be stored, including tool temperature and number of times the power tool has been turned on.

As admitted above, Bauer discloses a power tool with a ROM memory 15 that control information for controlling the rotary speed value. Bauer, col. 4, lns. 37-40. Bauer however does not disclose storing in this memory use profile information as tool temperature, length of use and/or the number of times the tool has been turned on.

By contradistinction, Claim 26 calls for "the stored information [to comprise] at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on." Claim 30 calls for "the stored information [to comprise] length of use." This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Obtaining this use information provides useful insights as to how a user uses and interacts with a power tool, which in turn can be used to design a better product. Spec., p. 1, lns. 14-16. Because Bauer does not disclose or suggest a memory for storing use information, or the specific information to be stored, as called for in Claims 26 and 30, Bauer cannot render Claims 26 and 30 unpatentable.

In addition, there is no suggestion to modify Bauer's preprogrammed memory storing control information with a storage memory for length of use and/or other use parameters as implied by the Examiner for several reasons. First, such modification would change the principle of operation. As discussed above, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the present case, the ROM in Bauer is used for controlling the

motor speed. Since the Bauer memory does not store length of use information or other information as to how the user uses the tool, the principle of using a memory for controlling a parameter is changed.

Second, such modification would render the Bauer device unsatisfactory for its intended purpose. If the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As admitted by the Examiner, the Bauer device has a memory with control information for controlling and optimizing the motor speed. If the Bauer memory is replaced with a memory for storing use profile information with length of use information, etc., then the memory will not have the necessary control information for controlling and optimizing the motor speed. Accordingly, such modification would render the Bauer device unsatisfactory for its intended purpose. For these reasons, no suggestion exists to modify Bauer as proposed by the Examiner. Therefore, Bauer cannot render Claims 26 and 30 unpatentable.

The Examiner has ignored this argument and alleged that, as to Claim 30, "the stored information comprising length of use type data, absent any criticality, is considered to be nothing more than a choice of engineering skill, because neither non-obvious nor unexpected results, i.e, results which are different in kind and not in degree from the results of the prior art, will be obtained as long as an operator will be able to optimize the parameters of the tool." Applicants/appellant submit that the present invention provides "results which are different in kind and not in degree from the results of the prior art" and that the type of stored information is critical. Since Bauer does not store information as to how the power tool is used, including the length of use, it cannot deliver this data to engineers that can use it for better product design. On the other

hand, the intent of the present invention is to store and deliver actual use data to engineers so they can design better tools. Because the results are radically different, the storing of length of use data is critical. Thus, Claims 26 and 30 are patentable over Bauer.

C. Claims 27-28 are Patentable over Bauer.

The Board should reverse the Examiner's final rejection of Claims 27-28 for not including having all the claimed elements.

Claims 27-28 are ultimately dependent upon Claim 25, and thus the arguments of Section IX(A) above apply. In addition, Claim 27 requires that the stored information be downloadable. Claim 28 further requires that the stored information be downloadable into a computer.

As admitted above, Bauer discloses a power tool with a ROM memory 15 that control information for controlling the rotary speed value. Bauer, col. 4, lns. 37-40. Bauer however does not disclose downloading this information, especially into a computer.

By contradistinction, Claim 27 calls for "the stored information [to be] downloadable." Claim 28 further requires that "the stored information [be] downloadable into a computer." This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Obtaining this use information provides useful insights as to how a user uses and interacts with a power tool, which in turn can be used to design a better product. Spec., p. 1, lns. 14-16.

Because Bauer does not disclose downloading information, the Examiner takes official notice with regard to Claim 28 that "the stored information is downloadable into a computer since it is well known in the art to use a computer to optimize a process by using information stored in memory for feedback." Even assuming for the sake of argument that the subject matter of the

official notice is correct, the Examiner has failed to meet the obviousness prima facie requirement that Bauer should be modified according to the subject matter of the official notice. This is because the Examiner has not pointed to any evidence that a motivation to modify Bauer in such manner exists.

Applicants/appellant submit there is no suggestion to modify Bauer's power tool with non-downloadable preprogrammed memory storing control information with a downloadable memory. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the present case, Bauer does not suggest to a person of ordinary skill in the art to convert a non-downloadable power tool into a downloadable tool. Why? Because the information stored in Bauer's ROM is known by the engineers. Accordingly, an engineer would not learn anything new from that pre-programmed ROM that a code chart in his possession would not already show. Thus, a person of ordinary skill in the art would see no need or desire to download the information from that ROM. In other words, Bauer does not suggest the proposed modification to a person of ordinary skill in the art. Therefore, Bauer cannot render Claims 27-28 unpatentable.

D. Claim 29 is Patentable over Bauer.

The Board should reverse the Examiner's final rejection of Claim 29 for not including having all the claimed elements.

Claim 29 is ultimately dependent upon Claim 25, and thus the arguments of Section IX(A) above apply. In addition, Claim 29 requires that the stored information be downloadable into a reader apparatus.

As admitted above, Bauer discloses a power tool with a ROM memory 15 that control information for controlling the rotary speed value. Bauer, col. 4, lns. 37-40. Bauer however does not disclose downloading this information into a reader apparatus.

By contradistinction, Claim 29 calls for "the stored information [to be] downloadable into a reader apparatus." This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Obtaining this use information provides useful insights as to how a user uses and interacts with a power tool, which in turn can be used to design a better product. Spec., p. 1, lns. 14-16.

Downloading the information into a reader apparatus allows someone to obtain the use information without having to take the power tool from a user, bring the tool to a specific place and directly connecting the tool to a computer. Instead, the person can connect the reader apparatus to the power tool, download the information, remove the reader apparatus and download the information in the reader apparatus into a computer for analysis. Because Bauer does not disclose the use of a reader apparatus, Bauer cannot render Claim 29 unpatentable.

Unlike in the other groups, the Examiner has not provided any counter-argument. Therefore, Applicants/appellant request that the Board reverse the Examiner's rejection of Claim 29.

X. APPENDIX

A copy of the claims involved in the appeal are hereby attached in an Appendix.

XI. CONCLUSION

Based on the foregoing, Applicants/appellant urge the Board to rule that Claims 25-32 are patentable over Bauer.

Respectfully submitted,

Adan Ayala
PTO Reg. No. 38,373
Attorney for Applicants/appellant

Appendix attached

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APPENDIX

25. A power tool comprising a memory for storing use profile information about the tool.

26. The power tool of Claim 25, wherein the stored information comprises at least one of the group consisting of tool temperature, length of use, and number of times tool has been turned on.

27. The power tool of Claim 25, wherein the stored information is downloadable.

28. The power tool of Claim 25, wherein the stored information is downloadable into a computer.

29. The power tool of Claim 25, wherein the stored information is downloadable into a reader apparatus.

30. The power tool of Claim 25, wherein the stored information comprises length of use.

31. The power tool of Claim 25, wherein the memory is non-volatile.

32. The power tool of Claim 25, wherein the memory comprises an E^2PROM memory.